

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicants: Tim Hitchman et al.

Application Number: 10/567,536

Filed: 01/03/2007

Title: Laccases, nucleic acids encoding them and methods for making and using them

Group Art Unit: 1652

Examiner: RAGHU, GANAPATHIRAM

Confirmation Number: 9324

**Request For Reconsideration Of Patent Term Adjustment**  
**Under 37 C.F.R. § 1.705**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir,

Further to the USPTO Notice of allowance mailed on January 21, 2010, informing the applicant that the patent term adjustment until the notice allowance of this patent application is 284 days, applicants hereby respectfully request reconsideration of the patent term adjustment (PTA) for the above mentioned patent application.

A copy of the notice of allowance has been attached.

Applicants request reconsideration of the patent term adjustment for the above noted application in light of the recent decision on January 7, 2010 from the United States District Court for the District of Columbia in Wyeth v. Kappos, case No. 2009-1120 (Judge James Robertson).

The court issued the decision finding that the U.S. Patent and Trademark Office's interpretation of the PTA statute is incorrect and the periods of 35 U.S.C. §154(b)(2)(A) delay "overlap" with 35 U.S.C. §154(b)(2)(B) delay only if they occur on the same day.

Applicants have recalculated PTA for the above mentioned patent under the court's interpretation of the PTA statute and have determined that the patent is entitled to 596 days PTA on the date of issue. Applicants hereby request to reconsider the total PTA at issue as 596 days.

**PTO Delay A (days): 346**

**PTO Delay B (days): 313**

**Overlap (days): 1**

**Applicant Delay (days): 62**

**PTA Calculation: (PTO Delay A + PTO Delay B - Overlap - Applicant delay)**

**PTA = (346 + 313 - 1 - 62) = 596 days**

The attached sheet provides details of the circumstances during the prosecution of the application resulting in the patent that constitutes a failure to engage in reasonable efforts to conclude processing or examination of an application.

As these errors are made by the U.S. Patent and Trademark Office in interpreting and applying the PTA, it is believed that no fee is due in conjunction with this filing. However the commissioner is authorized to charge any additional fees to Deposit Account Number 50-0661.

Respectfully Submitted

Dated: April 26, 2010

By /Jennifer Risser/  
Jennifer Risser (Reg. No.: 50,0661)  
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Document	Date	PTO Delay (A)	PTO Delay (B)	Applicant Delay	Overlap
Projected Issue Date of patent	07-27-2010				
Notice of Allowance and Fees Due	01-21-2010				
Request for continued examination	12-21-2009		313		
Applicant Arguments/Remarks Made in an Amendment	12-21-2009			62	
Applicant response due	10-20-2009				
Final Rejection	07-20-2009				
Amendment/Req. Reconsideration-After Non-Final Reject	05-12-2009				
Non-Final Rejection	02-12-2009	346			1
3 years from Commencement of National stage	02-11-2009				
PTO response Due	03-03-2008				
Patent application Date	01-03-2007				
30 months from Priority date (Commencement of National stage)	02-11-2006				
Priority date(US Provisional Application "60/494472")	08-11-2003				



## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22304-1450  
www.uspto.gov

## NOTICE OF ALLOWANCE AND FEE(S) DUE

40754 7900 01/02/2010  
VERENUM CORPORATION  
Intellectual Property Department  
P.O. Box 910550  
SAN DIEGO, CA 92191-0550

EXAMINER	
RASHMI GANAPATHIRAM	
ART UNIT	PATENT NUMBER

1652  
DATE MAILED: 01/21/2010

APPLICATION NO.	FILED DATE	PERSON NAMED INVENTOR	AI LOMBNEY DOCKET NO.	CONFIRMATION NO.
10/567,536	01/03/2007	Tim Hilleman	564462012600	9324

TITLE OF INVENTION: LACCASES, NUCLEIC ACIDS ENCODING THEM AND METHODS FOR MAKING AND USING THEM

APPL. TYPE	SMALL ENTITY	ISSUE FEE DUE	PUBLICATION FEE DUE	PREV. PAID ISSUE FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	YES	\$755	\$300	\$0	\$1055	04/21/2010

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. PROSECUTION ON THE MERITS IS CLOSED. THIS NOTICE OF ALLOWANCE IS NOT A GRANT OF PATENT RIGHTS. THIS APPLICATION IS SUBJECT TO WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE OR UPON PETITION BY THE APPLICANT. SEE 37 CFR 1.313 AND MPEP 1308.

THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN THREE MONTHS FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. THIS STATUTORY PERIOD CANNOT BE EXTENDED. SEE 35 U.S.C. 151. THE ISSUE FEE DUE INDICATED ABOVE DOES NOT REFLECT A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE IN THIS APPLICATION. IF AN ISSUE FEE HAS PREVIOUSLY BEEN PAID IN THIS APPLICATION (AS SHOWN ABOVE), THE RETURN OF PART B OF THIS FORM WILL BE CONSIDERED A REQUEST TO REAPPLY THE PREVIOUSLY PAID ISSUE FEE TOWARD THE ISSUE FEE NOW DUE.

## HOW TO REPLY TO THIS NOTICE:

I. Review the SMALL ENTITY status shown above.

If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

- A. If the status is the same, pay the TOTAL FEE(S) DUE shown above.
- B. If the status above is to be removed, check box 5b on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and twice the amount of the ISSUE FEE shown above, or

If the SMALL ENTITY is shown as NO:

- A. Pay TOTAL FEE(S) DUE shown above, or
- B. If applicant claimed SMALL ENTITY status before, or is now claiming SMALL ENTITY status, check box 5a on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and 1/2 the ISSUE FEE shown above.

II. PART B - FEE(S) TRANSMITTAL, or its equivalent, must be completed and returned to the United States Patent and Trademark Office (USPTO) with your ISSUE FEE and PUBLICATION FEE (if required). If you are charging the fee(s) to your deposit account, section "4b" of Part B - Fee(s) Transmittal should be completed and an extra copy of the form should be submitted. If an equivalent of Part B is filed, a request to reapply a previously paid issue fee must be clearly made, and delays in processing may occur due to the difficulty in recognizing the paper as an equivalent of Part B.

III. All communications regarding this application must give the application number. Please direct all communications prior to issuance to Mail Stop ISSUE FEE unless advised to the contrary.

**IMPORTANT REMINDER:** Utility patents issued on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.

# PART B - FEE(S) TRANSMITTAL

Complete and send this form, together with applicable fee(s), to: **Mail Stop ISSUE FEE**  
**Commissioner for Patents**  
**P.O. Box 1450**  
**Alexandria, Virginia 22313-1450**  
**or Fax (571)-273-2885**

INSTRUCTIONS: This form should be used for transmitting the ISSUE FEE; (if required) Blocks 1 through 5 should be completed where appropriate. All further correspondence including the Patent, advance orders and notification of maintenance fees will be mailed to the current correspondence address as indicated unless corrected below or directed otherwise in Block 1, by (a) specifying a new correspondence address; and/or (b) indicating a separate **TELE ADDRESS** for maintenance fee notification.

EXISTING CORRESPONDENCE ADDRESS: Check the Box 1 for any change of address

Note: A certificate of mailing can only be used for domestic mailings of the Fee(s) Transmittal. This certificate cannot be used for any other accompanying papers. Each additional paper, such as an assignment or formal drawing, must have its own certificate of mailing or transmittal.

## Certificate of Mailing or Transmittal

I hereby certify that this Fee(s) Transmittal is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to the Mail Stop ISSUE FEE address above, or being live/mile transmitted to the USPTO (571) 273-2885, on the date indicated below:

(Deposited in)
(Postage)
(Date)

VERENICE CORPORATION  
 Intellectual Property Department  
 P.O. Box 910550  
 SAN DIEGO, CA 92191-0550

APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO
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10/561,536	01/01/2007	Tim Hutchman	56446/2012600	9124
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TITLE OF INVENTION: LACCASES, NUCLEIC ACIDS ENCODING THEM AND METHODS FOR MAKING AND USING THEM

APPLN TYPE	SMALL ENTITY	ISSUE FEE DUE	PUBLICATION FEE DUE	PREV. PAID ISSUE FEE	TOTAL FEES DUE	DATE DUE
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nonprovisional	YES	\$755	\$300	\$0	\$1055	04/21/2010
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EXAMINER	ART UNIT	CLASS-SUBCLASS
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RAGH, GANAPATHIRAM	1652	435-180000
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1. Change of correspondence address or indication of "Fee Address" (37 CFR 1.303)

☐ Change of correspondence address (or Change of Correspondence Address form PTO/SB-122) attached.

☐ "Fee Address" indication (or "Fee Address" Indication form PTO/SB-47, Rev 05-02, or more recent) attached. Use of a **Customer Number** is required.

2. For printing on the patent from page, list

(1) the names of up to 3 registered patent attorneys or agents OR, alternatively,

(2) the name of a single firm (having as a member a registered attorney or agent) and the names of up to 2 registered patent attorneys or agents. If no name is listed, no name will be printed.

1. \_\_\_\_\_

2. \_\_\_\_\_

3. \_\_\_\_\_

3. ASSIGNEE NAME AND RESIDENCE DATA TO BE PRINTED ON THE PATENT (print or type)

PLEASE NOTE: Unless an assignee is identified below, no assignee data will appear on the patent. If an assignee is identified below, the document has been filed for recordation as set forth in 37 CFR 3.11. Completion of this form is NOT a substitute for filing an assignment.

(A) NAME OF ASSIGNEE

(B) RESIDENCE (CITY AND STATE OR COUNTRY)

Please check the appropriate assignee category or categories (will not be printed on the patent): ☐ Individual ☐ Corporation or other private group entity ☐ Government

4a. The following fee(s) are submitted:

☐ Issue Fee

☐ Publication Fee (No small entity discount permitted)

☐ Advance Order - # of Copies \_\_\_\_\_

4b. Payment of Fee(s). (Please first **reapply** any previously paid issue fee shown above)

☐ A check is enclosed.

☐ Payment by credit card. Form PTO-2038 is attached.

☐ The Director is hereby authorized to charge the required fee(s), any deficiency, or credit any overpayment, to Deposit Account Number \_\_\_\_\_ (enclose an extra copy of this form).

5. Change in Entity Status (from status indicated above)

☐ a. Applicant claims SMALL ENTITY status. See 37 CFR 1.27.

☐ b. Applicant is no longer claiming SMALL ENTITY status. See 37 CFR 1.27(g)(2).

NOTE: The Issue Fee and Publication Fee (if required) will not be accepted from anyone other than the applicant; a registered attorney or agent; or the assignee or other party in interest as shown by the records of the United States Patent and Trademark Office.

Authorized Signature \_\_\_\_\_

Date \_\_\_\_\_

Typed or printed name \_\_\_\_\_

Registration No. \_\_\_\_\_

This collection of information is required by 37 CFR 1.311. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and make suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, Virginia 22313-1450. **DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.**

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## UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/567,536	01/03/2007	Tim Hitchcock	56446301.2600	9324
EXAMINER				
RAGOTU, GANAPATHIRAM				
AK1 UN1		PATENT NUMBER		

45975 7860 01/24/2010  
VERENIUM CORPORATION  
Intellectual Property Department  
P.O. Box 910350  
SAN DIEGO, CA 92191-0350

1552  
DATE MAILED: 01/21/2010

**Determination of Patent Term Adjustment under 35 U.S.C. 154 (b)**  
(application filed on or after May 29, 2000)

The Patent Term Adjustment to date is 284 day(s). If the issue fee is paid on the date that is three months after the mailing date of this notice and the patent issues on the Tuesday before the date that is 28 weeks (six and a half months) after the mailing date of this notice, the Patent Term Adjustment will be 284 day(s).

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (<http://pair.uspto.gov>).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571)-272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at 1-(888)-786-0101 or (571)-272-4200.